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SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

EXAMINER
MCLEAN, NEIL R

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2008*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   Claims 1-27 are pending in this application.

Claims 1, 2-8, 12-13 and 18-24 have been amended, including

Independent Claims 1, 4, 5, 12, 18 and 23.

Claim Rejections - 35 USC § 112

2.   Claims 19-22 were rejected under 35 USC § 101for lacking sufficient antecedent

basis. The Examiner notes that Claims 19-22 have been amended and now comply

with 35 USC § 101. The rejection is withdrawn.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 4-11, and 18-27 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

In claims 4-11 and 18-27, a "computer program" is being recited; however,

computer program would reasonably be interpreted by one of ordinary skill in the art as

software, per se. This subject matter is not limited to that which falls within a statutory

category of invention because it is limited to a process, machine, manufacture, or a

composition of matter. Software is a function descriptive material and a function

descriptive material is non-statutory subject matter.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-27 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1, 4, 5, 6, 8, 12, 16-18 and 23 are rejected under 35 U.S.C. 102(b) as

being anticipated by Sesek et al. (US 7,054,021) hereafter 'Sesek'.

Regarding Claim 1: (Currently Amended)

        Sesek discloses a method of delivering printed documents from a workstation to

a destination user comprising:

        inputting a name of the destination user (a user may send multiple customized print jobs to

user-selected print destinations; Column 2, lines 4-5)

        inputting a network address corresponding to the name of the destination user

(The distribution list may include additional destinations for a file or document other than a set of printers. For

example, the distribution list may also send soft copies of the electronic document to designated folders or <u>electronic mail accounts</u> on the user's computer or on a recipient's computer. Hence, a user, in a single operation, may send an electronic document to multiple printers and to designated folders and e-mails accounts; Column 6, lines 10-18)

designating an image forming apparatus based upon information selected from the group comprising the name and the network address (Print jobs may also be sent to network storage devices or other <u>network destinations</u>; Column 3, lines 33-34: For example, in FIG. 2, printer selection display window 42 may include a user-selectable submit icon, such as submit button 50 that submits the master print job to the appropriate printers in a single command; Column 5, lines 7-11)

a distribution step to deliver the electronic data to the image forming apparatus selected by the reference step (The electronic document (at 306) is then sent to each device on the distribution list; Column 7, lines 1-3).

Regarding Claim 4: (Currently Amended)

Claim 4, a computer readable medium storing computer executable instructions is rejected for the same reason(s) as Claim 1.

Regarding Claim 5: (Currently Amended)

Sesek discloses a method of directing print jobs using a print driver installed in or available to a workstation (Computer 12, may also include one or more print drivers, which are used to control each associated printer; Column 3, lines 19-21), the method comprising

the print driver opening a window for receiving information about a print job to be printed (FIG. 2, a representative user interface is shown generally at 40),

receiving via the window an identification of a user to receive printed documents from the print job (The distribution list may include additional destinations for a file or document other than a set

of printers. For example, the distribution list may also send soft copies of the electronic document to designated

folders or <u>electronic mail accounts</u> on the user's computer or on a recipient's computer. Hence, a user, in a single

operation, may send an electronic document to multiple printers and to designated folders and e-mails accounts;

Column 6, lines 10-18)

receiving via the window a selection of an image forming apparatus based upon

information about the identified user, wherein the selection is made from a search of a

database that associates plural image forming apparatuses with plural users (As shown at

208, each set of print attributes may be stored as a print distribution list. The print distribution list may be saved on

any memory storage device. A user may at a later date retrieve the stored print distribution list and send a

subsequent electronic document to appropriate destinations according to the pre-selected print attributes.

Additionally, a user may alter the print attributes on the list to customize the print distribution list; Column 6, lines 39-

47)

directing the print job to the selected image forming apparatus step (The electronic

document (at 306) is then sent to each device on the distribution list; Column 7, lines 1-3).

Regarding Claim 6: (Currently Amended)

Sesek further discloses the method of directing print jobs of claim 5 wherein the

information comprises a title of the print job (As shown in FIG. 2, print jobs 48 collectively form a

master print job. The master print job may be stored as a print distribution list; Column 5, lines 54-61.)

Note: The Examiner perceives that when a print job is saved, and subsequently

distributed that it inherently has a Name/Title of the job for identification purposes.

Regarding Claim 8: (Currently Amended)

Sesek further discloses the method of directing print jobs of Claim 5 further

comprising

after receiving information identifying the user to receive the printed documents,

preparing a list of image forming apparatuses form the database, the list ranking the

listed image forming apparatuses based upon the proximity of the listed image forming

apparatuses to the identified user, Sequesting selection of one of the image forming

apparatuses form the list (A user may choose a printer that is in close proximity to the user, or which is in

close proximity to an intended recipient of the document; Column 1, lines 20-22).

Regarding Claim 12:

Claim 12, a method claim is rejected for the same reason(s) as Claim 5.

Regarding Claim 16:

The method of delivering printed documents of claim 12 further comprising in the

selecting step, preparing a list of image forming apparatuses, the list ranking the listed

image forming apparatuses based upon the proximity of the listed image forming

apparatuses to the identified user after the selecting step, requesting selection of one of

the image forming apparatuses from the list ((A user may choose a printer that is in close proximity to

the user, or which is in close proximity to an intended recipient of the document; Column 1, lines 20-22).

Regarding Claim 17:

The method of delivering printed documents of claim 12 wherein the network

addresses comprises an IP address closeness is determined based upon identity of

subnets in the network addresses and closeness of host portions of the network

addresses((A user may choose a printer that is in close proximity to the user, or which is in close proximity to an

intended recipient of the document; Column 1, lines 20-22).

Regarding Claim 18:

Claim 18, a computer readable medium storing computer executable instructions

is rejected for the same reason(s) as Claim 5.

Regarding Claim 23:

Claim 23, a computer readable medium storing computer executable instructions

is rejected for the same reason(s) as Claim 12.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 2, 3, 7, 9-11, 13-15, 19-22, and 24-27 are rejected under 35 U.S.C.

103(a) as being unpatentable over Sesek and further in view of Smith et al. (US

6,529,956) hereafter 'Smith'.

Regarding Claim 2:

Sesek discloses the method of delivering printed documents as in Claim 1 however;

Sesek does not disclose expressly setting up a lock code.

Smith discloses setting up a lock code (While the binary file delivery system 10a offers the flexibility to support specialized security solutions, it readily supports current industry-standard security solutions as described in Column 5, lines 40-59).

Smith & Sesek are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of directing document delivery.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set up a lock code when directing documents.

The suggestion/motivation for doing so would be to better control the distribution of documents. As disclosed by Smith in the background of invention most systems that allow the appending of an associated file are designed to allow a single user to send unsecured files to an associate or friend, and neither allow for controlled automated distribution to multiple recipients, nor do they provide advanced accounting, billing or other such features (e.g., receipt notification). E-mail gateways also limit the applicability of attachments, and do not solve the problems of security and receipt notation or acknowledgment.

Therefore, it would have been obvious to combine Smiths secure document delivery method with Sesek's method of printing multiple print jobs in a single action to obtain the invention as specified in order to provide several levels of security for the directed files.

Regarding Claim 3:

Sesek discloses the method of delivering printed documents as in Claim 1

however;

Sesek does not disclose expressly setting up sending a notification mail which

notifies that the electronic data has been transmitted to the mail address inputted at the

mail address inputting step when delivering the electronic data to the selected image

forming apparatus.

Smith et al. discloses the method of delivering printed documents of claim 1

comprising setting up sending a notification mail which notifies that the electronic data

has been transmitted to the mail address inputted at the mail address inputting step

when delivering the electronic data to the selected image forming apparatus (The notifier 66

is used to handle E-mail notification 20 (FIG. 2) to the recipient 22. The forwarder 58 (FIG. 10) is used to forward

store items 48 (FIG. 4) to other servers 12a-n (FIG. 2), using a server connector 80 (FIG. 7). Since not all E-mail

notifications may be received, an E-mail scanner is used to check the server mail account for "returned" E-mail, and

then to match it with the failed transaction as described in Column 7, lines 29-36; (An endpoint is typically a *recipient*

22 with Internet access, but can also be another entity, such as a facsimile machine 172 or *a printer 178 (FIGS. 14,*

15) as described in Column 3, lines 63-65).

Smith & Sesek are combinable because they are from the same field of endeavor

of image processing; e.g., both references disclose methods of directing document

delivery.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to send a notification mail notifying the recipient that electronic data has

been delivered.

The suggestion/motivation for doing so would be to better control the distribution

of documents. As disclosed by Smith in the background of invention most systems that

allow the appending of an associated file are designed to allow a single user to send

unsecured files to an associate or friend, and neither allow for controlled automated

distribution to multiple recipients, nor do they provide advanced accounting, billing or

other such features (e.g., receipt notification). E-mail gateways also limit the applicability

of attachments, and do not solve the problems of security and receipt notation or

acknowledgment.

Therefore, it would have been obvious to combine Smiths secure document

delivery method with Sesek's method of printing multiple print jobs in a single action to

obtain the invention as specified in order to provide several levels of security for the

directed files.

Regarding Claim 7:

Sesek discloses the method of delivering printed documents as in Claim 5

however;

Sesek does not disclose expressly requesting confirmation of the selected image

forming apparatus and receiving a confirmation of the selected image forming

apparatus.

Smith et al. discloses requesting confirmation of the selected image forming

apparatus and receiving a confirmation of the selected image forming apparatus (The

notifier 66 is used to handle E-mail notification 20 (FIG. 2) to the recipient 22. The forwarder 58 (FIG. 10) is used to

forward store items 48 (FIG. 4) to other servers 12a-n (FIG. 2), using a server connector 80 (FIG. 7). Since not all E-

mail notifications may be received, an E-mail scanner is used to check the server mail account for "returned" E-mail, and then to match it with the failed transaction as described in Column 7, lines 29-36; (An endpoint is typically a *recipient 22 with Internet access*, but can also be another entity, such as a facsimile machine 172 or *a printer 178 (FIGS. 14, 15)* as described in Column 3, lines 63-65)

Smith & Sesek are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of directing document delivery.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to request/receive confirmation from the selected image forming apparatus.

The suggestion/motivation for doing so would be to better control the distribution of documents. As disclosed by Smith in the background of invention most systems that allow the appending of an associated file are designed to allow a single user to send unsecured files to an associate or friend, and neither allow for controlled automated distribution to multiple recipients, nor do they provide advanced accounting, billing or other such features (e.g., receipt notification). E-mail gateways also limit the applicability of attachments, and do not solve the problems of security <u>and receipt notation or acknowledgment.</u>

Therefore, it would have been obvious to combine Smiths secure document delivery method with Sesek's method of printing multiple print jobs in a single action to obtain the invention as specified in order to provide several levels of security for the directed files.

Regarding Claim 9: (Original)

Claim 9, a method claim is rejected for the same reason(s) as Claim 3.

Regarding Claim 10: (Original)

Sesek discloses the method of delivering printed documents as in Claim 5

however;

Sesek does not disclose expressly wherein the notifying comprises sending a

message to the user with information identifying the selected image forming apparatus.

Smith et al. discloses requesting confirmation of the selected image forming

apparatus and receiving a confirmation of the selected image forming apparatus (Account

and transaction management provides no value unless sophisticated means of reporting are provided, For example,

users 16 can be provided with a full report of a given transaction, including such information as which documents

were delivered to whom, how many users have confirmed delivery of the document, or for billing purposes, the costs

associated with the transaction as described in Column 12).

Smith & Sesek are combinable because they are from the same field of endeavor

of image processing; e.g., both references disclose methods of directing document

delivery.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to send a message to the user with information identifying the selected

image forming apparatus.

The suggestion/motivation for doing so would be to better control the distribution

of documents. As disclosed by Smith in the background of invention most systems that

allow the appending of an associated file are designed to allow a single user to send

unsecured files to an associate or friend, and neither allow for controlled automated

distribution to multiple recipients, nor do they provide advanced accounting, billing or

other such features (e.g., receipt notification). E-mail gateways also limit the applicability

of attachments, and do not solve the problems of security and receipt notation or

acknowledgment.

Therefore, it would have been obvious to combine Smiths secure document

delivery method with Sesek's method of printing multiple print jobs in a single action to

obtain the invention as specified in order to provide several levels of security for the

directed files.

Regarding Claim 11:

Sesek discloses the method of delivering printed documents as in Claim 5

however;

Sesek does not disclose expressly the method of including a tracking identifier.

Smith discloses including a tracking identifier (FIG. 20 is a block diagram which depicts a

document delivery system that includes private, trackable URLs for directed document delivery according to the

invention as discloses in Column 15, lines 42-44) Smith & Sesek are combinable because they are

from the same field of endeavor of image processing; e.g., both references disclose

methods of directing document delivery.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to include a tracking identifier.

The suggestion/motivation for doing so would be to better control the distribution

of documents. As disclosed by Smith in the background of invention most systems that

allow the appending of an associated file are designed to allow a single user to send

unsecured files to an associate or friend, and neither allow for controlled automated

distribution to multiple recipients, nor do they provide advanced accounting, billing or

other such features (e.g., receipt notification). E-mail gateways also limit the applicability

of attachments, and do not solve the problems of security and receipt notation or

acknowledgment.

Therefore, it would have been obvious to combine Smiths secure document

delivery method with Sesek's method of printing multiple print jobs in a single action to

obtain the invention as specified in order to provide several levels of security for the

directed files.

Regarding Claim 13:

Claim 13, a method claim is rejected for the same reason(s) as Claim 6.

Regarding Claim 14:

Claim 14, a method claim is rejected for the same reason(s) as Claim 7.

Regarding Claim 15:

Claim 15, a method claim is rejected for the same reason(s) as Claim 7.

Regarding Claim 19:   (Currently Amended)

Claim 19, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 20: (Currently Amended)

Claim 20, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 21: (Currently Amended)

Claim 21, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 22: (Currently Amended)

Claim 21, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 24: (Currently Amended)

Claim 24, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 25: (Currently Amended)

Claim 25, a computer readable medium storing computer executable instructions
is rejected for the same reason(s) as Claim 1.

Regarding Claim 26: (Currently Amended)

Claim 26, a computer readable medium storing computer executable instructions is rejected for the same reason(s) as Claim 1.

Regarding Claim 27: (Currently Amended)

Claim 27, a computer readable medium storing computer executable instructions is rejected for the same reason(s) as Claim 1.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noble et al. (US 7,185,066) discloses a system for sharing computer data between two or more sharing partners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-1679. The examiner can normally be reached on Monday through Friday 7:30AM-4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625